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Amendment
Attorney Docket No. S63.2B-10692-US01

Remarks

This Amendment is in response to the Office Action dated June 2, 2005. In the Office Action, claims 1 and 19 were rejected under 35 USC § 102(b). Claims 1-8 and 24-25 were rejected under 35 USC § 102(b). Claims 20-23 were rejected under 35 U.S.C. § 103(a). Claims 2-8, 10-13, 15-17 and 33-38 were rejected under 35 U.S.C. § 103(a). Claims 9 and 18 were rejected under 35 U.S.C. § 103(a).

The paragraphs below correspond to those of the Office Action.

35 USC § 102

Claims 1 and 19 were rejected under 35 USC § 102(b) as being anticipated by Giba et al. (U.S. 5,876,373). In order to advance prosecution, Applicant has amended instant independent claim 1 to include a recitation that the at least one heat transmitting mechanism comprises at least one fluid transmission lumen and that the inner shaft is constructed of at least three layers. Applicant respectfully asserts that Giba does not teach or suggest all of the elements of the instant claims in that Giba does not teach or suggest an inner tube constructed of at least three layers as recited in the instant claims.

According to the Office Action, the inner layer of the catheter in Giba is constructed of three layers: the center tube 114, the shim 120 and the helical coil spring 130.

Applicant respectfully asserts that the shim is not a layer of the center tube. The center tube is attached at one end to a distal tip 118 (see 8:32-33). The shim extends between the distal tip and the shim anchor sleeve 112 (see 8:55-56). The shim is anchored to the distal tip by a tang 121 (see 8:60-62). The shim anchor sleeve is attached to the inner wall of the outer jacket (see 8:51-52). The center tube slidably extends through the shim anchor sleeve (see 8:50-51). Thus, the shim cannot be considered a layer of the center tube because it is connected between the distal tip and the shim anchor sleeve, both of which are not part of the center tube since the center tube is attached to the distal tip and the center tube is slidable within the shim anchor sleeve. Therefore Giba does not teach or suggest a shaft constructed of at least three layers.

Withdrawal of the rejection is respectfully requested.

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35 USC § 102

Claims 1-8 and 24-25 were rejected under 35 USC § 102(b) as being anticipated by Danforth. (U.S. 4,822,345).

In order to advance prosecution, Applicant has amended instant independent claim 1 to include a recitation that the inner shaft is constructed "of at least three layers". Applicant respectfully asserts that Danforth does not teach or suggest the use of a shaft constructed of at least three layers. Therefore, at least for this reason, Danforth does not teach or suggest all of the elements of instant independent claim 1 or any of claims 2-8 and 24-25 dependent therefrom. Withdrawal of the rejection is respectfully requested.

35 USC § 103

Claims 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giba. The Office Action states that it would have been an obvious design choice to use the materials recited in the instant claims without any evidence to support this statement.

Claims 20-23 depend from claim 1 and are patentable over Giba at least for the reasons discussed above with respect to claim 1.

Concerning the conclusory statement of the Office Action, that the materials recited in the instant claims is "merely a choice of materials", it is well known in the art that the choice of materials can lend patentable distinction to a claim. Moreover, the Office Action has not provided any evidence that:

1. a first layer defining a guide wire lumen at least partially constructed from HDPE is "merely a choice of materials" (see claim 20)
2. a first layer engaged to a second layer of anhydride modified linear low density polyethylene is "merely a choice of materials" (see claim 21)
3. a third layer at least partially constructed of a material exhibiting an order/disorder transformation during a change in the temperature of the third layer is "merely a choice of materials" (see claim 22).

To the extent that the Office Action considers the limitations to be "merely a choice of materials", Applicant requests that the Examiner provide documentation showing that the use of the materials recited in claims 20-23 in the manner recited in these claims is obvious.

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Withdrawal of the rejection is respectfully requested.

35 USC § 103

Claims 2-8, 10-13, 15-17 and 33-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giba in view of Ueda (U.S. 4,799,474).

The proposed addition of a shape memory wire, a heat conducting tube and fluid source of Ueda does nothing to address the failure of Giba to teach or suggest all of the elements of instant independent claim 1 from which claims 2-8, 10-13, 15-17 and 33-38 depend.

At least for this reason, claims 2-8, 10-13, 15-17 and 33-38 are patentable over the proposed combination.

Furthermore, claims 10-11 require that the at least one fluid transmission lumen is defined by a lumen wall having a thickness of either 0.002 inches or less or a thickness of about 0.001 inches or less. Claims 12-13 requires that the at least one fluid transmission lumen has a diameter of about 0.002 inches to about 0.008 inches or a diameter of about 0.003 inches. Ueda does not have explicit disclosure in the specification for the tube (90) having a wall thickness about 0.001 inches or less or for the tube (90) having a diameter of about 0.003 inches. It is well established that when a reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.

Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (citing *See In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value."); *In re Olson*, 212 F.2d 590, 592, 101 USPQ 401, 402 (CCPA 1954); cf. Manual of Patent Examining Procedure Section 2125 (1998)).

Withdrawal of the rejection is respectfully requested.

35 USC § 103

Claims 9 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giba in view of Ueda.

Ueda does nothing to address the failure of Giba to teach or suggest all of the elements of instant independent claim 1 from which claims 9 and 18 depend.

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At least for this reason, claims 9 and 18 are patentable over the proposed combination.

Withdrawal of the rejection is respectfully requested.

Conclusion

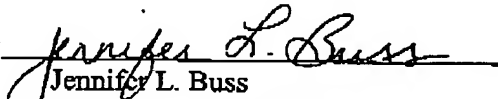
In light of the above comments, claims 1-2, 4-13, 15-17, 19-25 and 33-38 are believed to be in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

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Date: September 6, 2005

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